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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/616,404 07/14/00 CHANG

Y CHANG Y-4

EXAMINER

QM32/0801

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COMSTOCK, D.  
ART UNIT

PAPER NUMBER

3732  
DATE MAILED:

08/01/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/616,404

Applicant(s)

CHANG, YONG JIN

Examiner

David C. Comstock

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Attachment A*.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamburg (1,942,332) in view of Chang (5,782,248).

Hamburg discloses an artificial fingernail comprising a nail body 11 made from a transparent material (see col. 1, lines 17-24). The body has a nail bed portion and a nail tip portion. The nail bed portion corresponds in size and shape to the nail bed of a natural fingernail and is adapted to be adhered to a natural fingernail (see Fig. 1 and col. 2, lines 84-88). Hamburg does not disclose a nail tip portion containing an opaque decoration that obscures the natural nail tip. Chang discloses a nail decoration 16 having an opaque portion 17 covering the nail tip and obscuring the natural nail tip and a decorative design 15 applied over the entire nail to enhance the French manicure style (see col. 1, lines 34-42 and Fig. 2a). In another embodiment Chang discloses using white paint 35 to cover the nail tip to enhance the appearance of the French manicure (see col. 1, lines 49-56). Chang also discloses applying a transparent sealer 33 over the nail to further secure the decoration and to protect the appearance of the French manicure (see col. 3, lines 49-52). It would have been obvious to one of

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ordinary skill in the art at the time the invention was made to provide the artificial fingernail of Hamberg with a nail decoration having an opaque portion covering the nail tip in view of Chang in order to provide an enhanced French manicure style and improve the appearance of the nail. With regard to claim 2, Chang discloses the use of white paint covering the entire nail tip portion to enhance the appearance of the French manicure. With regard to claim 3, Chang discloses a decorative design applied over the entire nail to enhance the French manicure style and improve the appearance of the nail. With regard to claim 4, Chang discloses the use of a transparent sealer applied over the nail to further secure and protect the decoration.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamburg (1,942,332) in view of Chang (5,782,248) and further in view of Bartolucci (3,982,551).

The device of the combination of Hamburg as modified by Chang discloses the claimed invention except for providing a kit with at least 10 artificial fingernails and a translucent pink adhesive through which the natural nail color is visible. Bartolucci discloses an artificial fingernail kit 10 having at least 10 artificial fingernails 14 and an adhesive 70 to make the artificial fingernails easy to manufacture, package, and use (see col. 1, lines 13 and 14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of the combination of Hamburg as modified by Chang with the artificial fingernail kit in further view of Bartolucci in order to make the artificial fingernails easy to manufacture, package, and use. With regard to the color of the adhesive, It would have been obvious to one of

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ordinary skill in the art at the time the invention was made to make the adhesive translucent pink so that it blends in with the natural nail.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakata et al. (4,615,348) in view of Chang (5,782,248).

Nakata et al. disclose a method of applying artificial fingernails comprising applying a translucent pink adhesive to an artificial nail and placing the nail bed portion of the artificial nail over a natural nail bed (see col. 3, line 34 and col. 4, lines 2-14). Nakata et al. do not disclose a nail tip portion containing an opaque decoration that obscures the natural nail tip. Chang discloses a nail decoration 16 having an opaque portion 17 covering the nail tip to enhance the French manicure style (see col. 1, lines 34-42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the method of Nakata et al. with the opaque nail decoration covering the nail tip in view of Chang in order to provide a French manicure style and improve the appearance of the nail.

### ***Response to Arguments***

Applicant's arguments filed 14 July 2001 have been fully considered but they are not persuasive.

In response to Applicant's argument that there is no suggestion to combine the references, it is noted that the rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent

established by prior case law. The test for combining references is what the references as a whole would have suggested to one of ordinary skill in the art. *In re Sheckler*, 168 USPQ 716 (CCPA); *In re McLaughlin*, 170 USPQ 209 (CCPA 1971); *In re Young*, 159 USPQ 725 (CCPA 1968); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the references as a whole would have suggested a ready-to-apply artificial nail product incorporating the decorative features of Chang (5,782,248).

In response to Applicant's argument that the combination of Hamberg (1,942,332) and Chang (5,782,248) does not render Applicant's claims obvious, it is noted that the artificial nail of Hamberg is constructed from a transparent material through which the natural nail bed is visible. It is also noted that Hamberg includes a dividing line between the nail bed portion and the nail tip portion that generally corresponds to the transition of a natural nail from bed to tip. (See Attachment A and Hamberg, col. 1, lines 17-22.) Furthermore, the nail tip portion 35 of Chang obscures the natural nail tip, i.e., "the free edge of the nail" (see Chang, col. 3, line 31).

In response to Applicant's argument that the combination of Nakata et al. (4,615,348) and Chang (5,782,248) does not render Applicant's claims obvious, it is noted that a dividing line is formed on the artificial nail of Nakata et al. by the inner edge of the nail tip portion 35 of Chang. This dividing line is substantially aligned with the transition of the natural nail from bed to tip since the nail tip portion 35 of Chang obscures the natural nail tip, i.e., "the free edge of the nail". (See Chang, col. 3, line 31.)

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**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Noskin (3,786,821)

Langman (2,241,272)

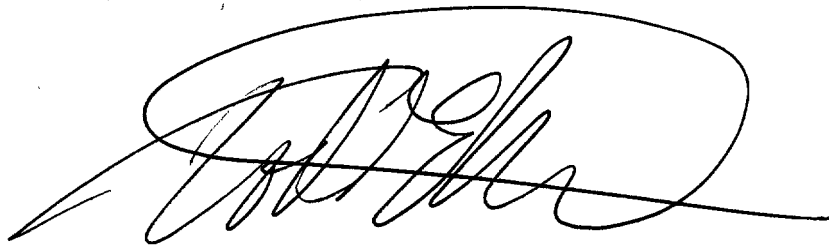
Petty (2,633,139)

Montemurro et al. (5,658,415)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.

DC

D.C. Comstock  
July 30, 2001

A large, stylized handwritten signature in black ink, likely belonging to Todd E. Manahan, is written over a horizontal line.

**Todd E. Manahan**  
**Primary Examiner**